

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES A. SIMMONS

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Appeal No. 1997-0595  
Application No. 08/154,911<sup>1</sup>

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HEARD: November 15, 1999

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Before STAAB, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 8, 10 and 12 to 17, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

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<sup>1</sup> Application for patent filed November 19, 1993.

BACKGROUND

The appellant's invention relates to a cushioning conversion machine including a pad-transferring assembly (specification, p. 1). An understanding of the invention can be derived from a reading of exemplary claim 3, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Engel 1937	2,101,170	Dec. 7,
Johnson 1970	3,509,797	May 5,
Ottaviano 9, 1980 (Ottaviano '776)	4,237,776	Dec.
Ottaviano 10, 1985 (Ottaviano '716)	4,557,716	Dec.
D'Angelo et al. 1987 (D'Angelo)	4,699,031	Oct. 13,

Claims 13 to 17<sup>2</sup> stand rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention, and/or for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claim 3 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Johnson.

Claims 1 to 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of D'Angelo.

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<sup>2</sup> While claim 17 was not specifically included in this rejection, we conclude that the examiner intended claim 17 to be included since claim 17 is dependent on claim 16. Additionally, the appellant has grouped claims 14-17 to stand or fall with claim 13 with respect to this rejection (brief, p. 9).

Claims 1 to 6, 10 and 12-17<sup>3</sup> stand rejected under 35  
U.S.C.

§ 103 as being unpatentable over Ottaviano '776 in view of  
Engel.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as  
being unpatentable over Ottaviano '776 in view of Johnson and  
Engel.

Claims 1 to 4 and 12-17<sup>4</sup> stand rejected under 35 U.S.C.  
§ 103 as being unpatentable over Ottaviano '716.

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<sup>3</sup> While claim 17 was not specifically included in the statement of the rejection, we conclude that the examiner intended claim 17 to be included since claim 17 is mentioned in the body of the rejection. Additionally, the appellant has grouped claims 13-17 to stand or fall with claim 1 with respect to this rejection (brief, p. 8).

<sup>4</sup> While claim 17 was not specifically included in the statement of the rejection, we conclude that the examiner intended claim 17 to be included since claim 17 is mentioned in the body of the rejection. Additionally, the appellant has grouped claims 13-17 to stand or fall with claim 1 with respect to this rejection (brief, p. 9).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed August 21, 1996) and the examiner's reply (Paper No. 24, mailed May 13, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed August 1, 1996), reply brief (Paper No. 22, filed October 31, 1996) and response to examiner's reply (Paper No. 25, filed June 9, 1997) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The 35 U.S.C. § 112 rejection**

We will not sustain the rejection of claims 13 to 17 under 35 U.S.C. § 112, first and second paragraphs.

The only reason set forth by the examiner for this rejection was that

[s]ince claims 13-16 [sic, 13-17] are drawn to a method of producing a cut pad and claim 1 is drawn to a cushioning conversion machine, claims 13-16 [sic, 13-17] are rendered indefinite since it is unclear whether an [sic, a] method or an apparatus is being claimed.

Turning first to the examiner's rejection based upon the enablement requirement set forth in the first paragraph of 35 U.S.C. § 112, we note that the test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976). However, in order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re

Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). In this case, the examiner has **not** alleged any basis to question the enablement provided for the claimed invention. Since the examiner has not met his threshold burden by advancing acceptable reasoning inconsistent with enablement, the decision of the examiner to reject claims 13 to 17 under 35 U.S.C. § 112, first paragraph, is reversed.

Turning next to the examiner's rejection based upon the definiteness requirement set forth in the second paragraph of 35 U.S.C. § 112, we note that claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). In our view, the metes and bounds of claims 13 to 17 would be understood by one skilled in the art with a reasonable degree of precision and particularity. The

manner in which method claims 13 to 17 have been drafted to refer back to apparatus claim 1 does not make the claims indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1147 (Bd. Pat. App. & Int. 1992) and Manual of Patent Examining Procedure (MPEP) (7th Ed., July 1998) §§ 608.01(n) and 2173.05(f). Since claims 13 to 17 are definite, the decision of the examiner to reject claims 13 to 17 under 35 U.S.C. § 112, second paragraph, is reversed.

#### **The anticipation rejection**

We sustain the rejection of claim 3 under 35 U.S.C. § 102(b) as being anticipated by Johnson.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the



claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Johnson discloses a mechanism for producing cushioning dunnage. As shown in Figures 17-19, the dunnage producing mechanism includes a pair of coacting rollers 114, 114a which are driven to pull a strip of sheet-like material 104 through a crumpler or folding mechanism 96, a roller 116, a belt 118, a guide rod 148, a receptacle 150, and a cutter mechanism 152. As shown in the drawings, these elements are carried by a support.

The appellant argues that claim 3 is not anticipated by Johnson since Johnson's rod 148 does not (1) "frictionally engage the strip prior to it being cut," and (2) "frictionally transfer the cut pad away from the cutting assembly." We do not agree.

In our view, the claimed "pad-transferring assembly" of claim 3 is readable on Johnson's guide rod 148. In that regard, Johnson's guide rod 148 is clearly mounted to a frame downstream of the cutter mechanism 152 and acts to transfer the cut strip away from the cutter mechanism 152. In addition, as shown in Figure 19, Johnson's guide rod 148 frictionally engages the strip 104 prior to it being cut and then acts to frictionally transfer the cut piece of strip 104 away from the cutter mechanism 152 and towards the receptacle 150.<sup>5</sup>

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<sup>5</sup> We agree with the examiner's view (answer, p. 9) that friction exists between the guide rod 148 and the strip 104 both prior to the strip being cut by cutter mechanism 152 and after the strip has been cut.

Since claim 3 is anticipated by Johnson, the decision of the examiner to reject claim 3 under 35 U.S.C. § 102(b) is affirmed.

**The obviousness rejection utilizing Johnson**

We sustain the rejection of claims 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Johnson in view of D'Angelo but not the rejection of claims 1, 2, 5 to 8 and 10.

As noted above, claim 3 is anticipated by Johnson. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we sustain the examiner's rejection of claim 3 under 35 U.S.C. § 103 as being unpatentable over Johnson in view of D'Angelo.

Claim 4 adds to parent claim 3 the limitation that the "pad-transferring assembly" comprises "a conveyor which frictionally engages the strip prior to it being cut and frictionally transfers the cut pad away from the cutter assembly." In our view, this limitation is readable Johnson's guide rod 148 since Johnson's guide rod 148 acts as a gravity conveyor which frictionally engages the strip 104 prior to it being cut and then acts to frictionally transfer the cut piece of strip 104 away from the cutter mechanism 152 and towards the receptacle 150. Since as stated supra a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, we sustain the examiner's rejection of claim 4 under 35 U.S.C. § 103 as being unpatentable over Johnson in view of D'Angelo.

Claims 5 to 7 add to parent claim 4 the limitation that the "conveyor" comprises "a series of rollers." In our view, this limitation clearly is not taught by Johnson or suggested from the combined teachings of Johnson and D'Angelo. In that regard, while D'Angelo does teach a conveyor having a series

of rollers, it is our opinion that the teachings of D'Angelo would not have suggested replacing Johnson's guide rod 148 with a conveyor having a series of rollers. In our view, the only suggestion for modifying Johnson in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 5 to 7.

Claims 1, 2 and 8 include the limitation that the "pad-transferring assembly" is mounted to the frame downstream of the cutting assembly and "pulls the cut pad away from the cutting assembly." In our view, this limitation clearly is not taught by Johnson or suggested from the combined teachings of Johnson and D'Angelo. In that regard, while D'Angelo does teach a conveyor that pulls a cut product away from the

cutting assembly, it is our opinion that the teachings of D'Angelo would not have suggested replacing Johnson's guide rod 148 with a conveyor that pulls the cut product away from the cutting assembly. Once again it is our view that the only suggestion for modifying Johnson in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. It follows that we cannot sustain the examiner's rejection of claims 1, 2 and 8.

Claim 10 includes the limitation that the "pad-transferring assembly" engages "an upper surface of the cut pad." In our view, this limitation clearly is not taught by Johnson or suggested from the combined teachings of Johnson and D'Angelo. In that regard, while D'Angelo does teach a conveyor that engages an upper surface of the cut product, it is our opinion that the teachings of D'Angelo would not have suggested replacing Johnson's guide rod 148 with a conveyor that engages an upper surface of the cut product. Thus, it is our view that the only suggestion for modifying Johnson in the manner proposed by the examiner to meet the above-noted

limitation stems from hindsight knowledge derived from the appellant's own disclosure. It follows that we cannot sustain the examiner's rejection of claim 10.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Johnson in view of D'Angelo is affirmed with respect to claims 3 and 4 and reversed with respect to claims 1, 2, 5 to 8 and 10.

**The obviousness rejections utilizing Ottaviano '776**

We sustain the rejection of claims 1 to 6, 10 and 12-17 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '776 in view of Engel.

Ottaviano '776 discloses a cushioning dunnage producing and handling mechanism which is of relatively compact nature utilizing a multi-ply roll 12 of sheet-like stock material, such as paper. As the stock is pulled off the composite roll, the edges are rolled inwardly in a longitudinally convergent

chute 26, into generally superimposed condition. Pusher means 40 urges the sheet-like stock material laterally toward a confronting surface of the chute. Then the inwardly rolled stock is passed into a crumpler section 28 which attaches together the confronting portions of the rolled edges of the stock material generally centrally, in a direction lengthwise thereof, to retain the dunnage product in highly compressible, lightweight pad-like form. After passing from the exit opening 74 of the crumpler section 28, the continuously formed pad P of stock material may be severed by the cutter mechanism 76 mounted on the rear end of the machine at the exit opening 74 therein. Brackets 94 on the cutter frame locate and aid in supporting a table surface 96, on which the pad-like dunnage may be supported as it is emitted by the mechanism.

Engel's invention relates to the cutting of sheets from a continuous web of material. As shown in the drawings, Engel's sheeter includes a roll 10 of web material 11, a stationary knife 24, a cutting knife 27, and a conveyor 32. Engel



teaches that web material is engaged by the conveyor 32 prior to the cutting operation.

*Claims 1 to 6, 10 and 12-17*

The examiner determined (answer, p. 4) that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified "the dunnage production mechanism of Ottaviano by adding the Engel conveyor to transfer dunnage away from the cutting assembly." We agree. In fact, the appellant has admitted (specification, p. 3) that typically, the cut pad from a machine such as disclosed by Ottaviano '776 is transferred downstream to a table, **conveyor belt**, or bin.

Implicit in this rejection is the examiner's view that the above noted modification of Ottaviano '776 would result in an apparatus which corresponds to the apparatus recited in claims 1 to 6, 10 and 12 and a method which corresponds to the method recited in claims 13-17 in all respects.

The appellant argues that since the present invention is directed toward eliminating shingling and that Engel's system results in the formation of a series of overlapped sheets "it would not have been obvious to incorporate the Engel conveyor system into the Ottaviano cushioning conversion machine." We find this argument unpersuasive since all of the features of the secondary reference need not be bodily incorporated into the primary reference (see In re Keller, supra, at 642 F.2d 425, 208 USPQ 881) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (see Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). It is our opinion that the combined teachings of the applied prior art would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have mounted a conveyor to the frame 24 of Ottaviano '776 at the exit opening 74 thereof so that the cut pad-like dunnage would be conveyed away from the cutter mechanism 76 of Ottaviano '776 based upon it being well known in the art as shown by Engel to convey a cut product away from the cutter mechanism.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 6, 10 and 12-17 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '776 in view of Engel is affirmed.

*Claims 7 and 8*

We will not sustain the rejection of claims 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '776 in view of Johnson and Engel.

Claims 7 and 8 add to their respective parent claim the limitation that the "pad-transferring assembly" further comprises "a guide unit." Each of claims 7 and 8 sets forth details of the guide unit. In this rejection (answer, p. 5), the examiner relies upon Johnson's receptacle 150 as being suggestive of the claimed guide unit. We do not agree. In our view, the only suggestion for modifying Ottaviano '776 in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. It follows that the decision of

the examiner to reject claims 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '776 in view of Johnson and Engel is reversed.

**The obviousness rejection utilizing Ottaviano '716**

We sustain the rejection of claims 1 to 4 and 12-17 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '716.

In the final rejection<sup>6</sup> (p. 8) and the answer (p. 6), the examiner set forth his rationale as to why claims 1 to 4 and 12-17 would have been obvious under 35 U.S.C. § 103 over Ottaviano '716.

The appellant has not specifically contested this rejection based upon Ottaviano '716 in the brief, reply brief or response to examiner's reply. Instead, the appellant argued why these claims were patentable over Ottaviano '776.

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<sup>6</sup> Paper No. 16, mailed February 28, 1996.

Accordingly, we summarily sustain the rejection of claims 1 to 4 and 12-17 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '716 since the appellant has not specified any error in this rejection.

Moreover, it is our view that the examiner's rejection of claims 1 to 4 and 12-17 under 35 U.S.C. § 103 over Ottaviano '716 is sustainable based upon the same rationale we set forth above in our decision affirming the examiner's rejection of these claims under 35 U.S.C. § 103 as being unpatentable over Ottaviano '776 in view of Engel.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 13 to 17 under 35 U.S.C. § 112, first and second paragraphs, is reversed; the decision of the examiner to reject claim 3 under 35 U.S.C. § 102(b) as being anticipated by Johnson is affirmed; the decision of the examiner to reject claims 1 to 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Johnson in view of D'Angelo is affirmed with respect to claims 3 and 4 and

reversed with respect to claims 1, 2, 5 to 8 and 10; the decision of the examiner to reject claims 1 to 6, 10 and 12-17 under 35 U.S.C.

§ 103 as being unpatentable over Ottaviano '776 in view of Engel is affirmed; the decision of the examiner to reject claims 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '776 in view of Johnson and Engel is reversed; and the decision of the examiner to reject claims 1 to 4 and 12-17 under 35 U.S.C. § 103 as being unpatentable over Ottaviano '716 is affirmed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPEAL NO. 1997-0595 - JUDGE NASE  
APPLICATION NO. 08/154,911

APJ NASE

APJ McQUADE

APJ STAAB

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria

Henderson

**DRAFT TYPED:** 23 Nov 99

**FINAL TYPED:**

**HEARD:** November 15, 1999